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IN THE

Supreme Court of the United States

PLANET BINGO, LLC AND GARY WEINGARDT,
Petitioners,

v.

GAMETECH INTERNATIONAL, INC., RICHARD FEDOR, GARY HELD AND GRAHAM LEONARD,
Respondents.

On Petition For Writ Of Certiorari
To The United States Court of Appeals
for the Federal Circuit

REPLY BRIEF OF PETITIONER

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1. GameTech and the Courts Below Have Entirely Collapsed the Doctrine of Equivalents and Literal Infringement Analyses

According to GameTech, a patentee who presents claim limitations loses the right to assert equivalence for anything that is outside of their literal scope. *See* Opp. 19-20 (arguing that the doctrine of equivalents "does not allow patentees to capture or recapture subject matter that they chose to exclude by including particular limitations in their claims.") However, fundamentally, "[t]he scope of a patent is not limited to is literal terms but instead embraces all equivalents to the claims described." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 732 (2002). Thus, the absence of literal infringement is the beginning of the equivalence analysis – not its end.

As GameTech's reasoning lays bare, the net effect of the Federal Circuit's vitiation doctrine is to collapse literal infringement and infringement under the doctrine of equivalents. The result is that a finding of no literal infringement requires a finding of no infringement under the doctrine of equivalents, effectively eliminating the doctrine entirely. *See, e.g.,* David J.F. Gross, et al., *Claim Construction, Patent Infringement, and the Growing Importance of the Claim Vitiation Defense*, *in Patent Litigation 2005* 45, 86 (2005) ("Under claim vitiation, taken to its logical end, the doctrine of equivalents collapses into literal infringement.").

As this Court has held from its earliest decisions applying the doctrine of equivalents, the doctrine is in place to protect patent holders from "unimportant and insubstantial" substitutes or changes to the patented invention. *Festo,* 535 U.S. at 731; *see also* Pet. at 12-13. At bottom, that means that the courts below have an obligation

to determine, where a doctrine of equivalents claim is made, whether the difference between the claimed and accused elements is "insubstantial."[1] To do that, the courts must consider the evidence of record. Here, as in the majority of vitiation cases, that simply did not occur.

In trying to create the impression that the courts below relied upon a lack of Planet Bingo evidence to find no equivalence, GameTech asserts that the district court excluded [Planet Bingo expert] Ms. Barrick from testifying on infringement." Opp. 7. GameTech has mischaracterized the record – the district court did *not* exclude Ms. Barrick's testimony regarding the very issue presented by this appeal, and in fact the opposite is true.[2] Moreover, neither the district court nor the Federal Circuit purported to rely on an "exclusion" of Ms. Barrick's testimony to justify summary judgment in favor of GameTech – in fact, neither opinion contains any reference to Ms. Barrick or her testimony.

In addition, the Barrick testimony was far from the only evidence offered by Planet Bingo on equivalence. For example, Planet Bingo presented evidence that Rainbow Bingo's color and jewel winning combinations are displayed on an "attract graphic" *before* the first ball is called and,

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[1] As the Petition acknowledged (Pet. 25, n. 10), *Warner-Jenkinson* allowed flexibility in the "linguistic framework" for determining "equivalence" – i.e., "whether the substitute element plays a role substantially different from the claimed element." *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40 (1997). However, GameTech is clearly wrong when it states that the doctrine of equivalents is not focused on "insubstantial" differences. *See Festo, supra.*

[2] In a ruling separate from the one that is being challenged here, the district judge held: "Barrick is qualified and capable of testifying, for example, on the significance in bingo of the timing of marking indicia either before or after the first ball is drawn. Such testimony is relevant to the infringement inquiry." C.A.A. 3430. The only limitation that Judge Pro placed on Ms. Barrick was that he would not permit her to state the ultimate legal conclusion that Rainbow Bingo is infringing. *Id.*

indeed, that GameTech's own Rainbow Bingo patent filings call its winning combinations "predetermined" and "pre-defined." Fed. Cir. Opening Br. at 19, 55-57. The evidence presented was clearly compelling -- the district court found that Rainbow Bingo has "pre-determined aspects" and the Federal Circuit conceded that it "certainly" has a "predetermined winning combination." App. 9, 29a. Indeed, the district court stated that under one line of vitiation cases, "the slight difference in timing between before and after the first ball is drawn raises a genuine issue of fact on equivalence." App. 34-35a. GameTech ignores this.

Instead of basing their decisions on a lack of evidence, the courts below relied entirely on the linguistic finding that "after" is the antithesis of "before." *See* App. 12a ("the proposed application of the doctrine of equivalents would change `before' to `after . . ..'"); 34a ("`After' is the very antithesis of `before,' and cannot be its equivalent as a mater of law."). GameTech's attempt to infer an evidentiary analysis that did not take place reflects its discomfort in defending the *per se* vitiation rulings actually made.

Relatedly, the vitiation doctrine cannot be justified as a mere application of the "all elements" rule of *Warner-Jenkinson*, as GameTech attempts. *See* Opp. 9, 11. Given the Federal Circuit's remarkable statement that "Rainbow Bingo certainly contains a `progressive predetermined winning combination'" (App. 9a), there can be no pretense that the court below somehow found the "predetermined winning combination" element to be entirely missing in Rainbow Bingo. As shown by the decision in this case, the vitiation doctrine, "though ostensibly based on the All Elements Rule, far exceeds its mandate." Daniel H. Shulman & Donald W. Rupert, "*Vitiating*" *the Doctrine of Equivalents: A New Patent Law Doctrine*, 12 Fed. Circuit B.J. 457, 483-84 (2002-2003).

2. The Federal Circuit's Vitiation Case Law is in Internal Conflict

GameTech's argument that there is no conflict in the Federal Circuit's doctrine of equivalents decisions would come as a surprise to the district judge in this case, who specifically addressed it in his summary judgment ruling: "Two lines of cases have developed that either broadly or narrowly apply the doctrine of equivalents." App. 32a. According to the district judge, summary judgment for GameTech would be "appropriate" under one line of cases, and "inappropriate" under another. App. 34a. The Opposition fails to acknowledge or address these statements.

The cases that have narrowly applied the doctrine of equivalents, according to the district judge, included *Asyst Technologies, Inc. v. Emtrak, Inc.*, 402 F.3d 1188 (Fed. Cir. 2005); *Cooper Cameron Corp. v. Kvaerner Oilfield Products*, Inc., 291 F.3d 1317 (Fed. Cir. 2002); *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091 (Fed. Cir. 2000); and *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (1997). App. 32-33a. (This is far from an exhaustive list of *per se* vitiation cases. *See* note 3, *infra*.) Planet Bingo discussed each of these in its Petition, and included a particularly lengthy treatment of the *Moore* case, including Judge Newman's dissent. Pet. 14-15. Other than *Sage*, the Opposition fails to address any of these cases that were central to the district court's opinion, and that were highlighted in the Petition. GameTech's statement that there is no intra-circuit conflict is therefore premised on a simple disregard of those cases that help establish it, and that were critical to GameTech's victory below.

Continuing in its effort to gloss over the Federal Circuit's conflicting vitiation case law, GameTech asserts

that, as applied by the Federal Circuit, the vitiation doctrine is a "flexible, content-specific test" that focuses on whether "'the alleged equivalent can be fairly characterized as an insubstantial change from the claimed subject matter without rendering the pertinent limitation meaningless.'" Opp. 13 (quoting *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005)). GameTech's failure to discuss *Asyst*, *Cooper*, and *Moore* – each of which exemplifies a rigid, linguistic analysis rather than a "flexible" one – deprives GameTech's statement of all credibility.

Moreover, in trying to establish that the Federal Circuit's vitiation test as applied below is consistent with the teachings of *Warner-Jenkinson*, GameTech was constrained to cite to *Freedman Seating* – a case that one commentator has described as demonstrating "the degree of confusion and unpredictability the claim vitiation doctrine creates" - rather than the decision below. *See* Robert Pribish, *Freedman Seating Co. and the Claim Vitiation Doctrine*, 43 San Diego L. Rev. 379, 396 (May-June 2006). But there is nothing in the Federal Circuit's opinion in *this* case that would lead one to believe that the vitiation doctrine is a "flexible, content-specific test," and GameTech does not even attempt to point to such language. Examples of vitiation cases where the Federal Circuit applied a *per se* vitiation rule, are legion.[3]

The fact that there are a minority of Federal Circuit cases that analyze the evidence for substantial differences – like the *Ericcson* case discussed at length at pp. 17-18 of the Petition – only proves Planet Bingo's point that the vitiation case law is "confusing and irreconcilable." Pet. 14; *see also* Shulman & Rupert, "*Vitiating*" *the Doctrine of Equivalents*,

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[3] From 2000 to 2005, the Federal Circuit applied a *per se* vitiation rule in 19 of 21 cases that considered it. Thomas C. Fiala, *Preparing and Prosecuting a Patent That Holds Up in Litigation, in Patent Litigation 2006* 515, 525 n. 17 (2006).

12 Fed. Circuit B.J. at 458 ("the Federal Circuit has either signaled an abandonment of the DOE [doctrine of equivalents], or worse, made its application unworkably uncertain"). The issue is not whether the Federal Circuit has *ever* rejected a rigid application of the vitiation doctrine in favor of a focus on whether differences are insubstantial. Rather, the problem is that some cases have engaged in such analysis, while others – like the decision below and those in *Ortho-McNeill*, *Asyst*, *Cooper*, *Moore*, *Sage*, *Tronzo*, and others (*see* Pet. 14-18 and note 3, *supra*), have done something very different. Like the district court below, the public is left to wonder which line of cases is actually consistent with the doctrine of equivalents as articulated in *Festo*, *Warner-Jenkinson* and *Graver Tank*.

3. The Vitiation Doctrine Improperly Extends Prosecution History Estoppel

GameTech's brief confirms Planet Bingo's assertion that the vitiation doctrine constitutes an improper extension of prosecution history estoppel. GameTech argues repeatedly that the patentee acted intentionally in choosing the relevant claim language. *See* Opp.19 (""The inclusion of this timing requirement was deliberate."); *id.* ("[T]here is nothing inadvertent or unexpected about the requirement that the winning combination be determined before the bingo game begins."); *see also id.* at 21, 23. The Federal Circuit's opinion below contained similar language. App. 11a.

Saying that the patentee included a claim term "deliberately" says nothing, as far as the doctrine of equivalents is concerned. Of course, if the relevant claim term was narrowed during prosecution to obtain the patent – which is not alleged to have occurred here – then prosecution history estoppel may apply. *Festo*, 535 U.S. at 737. Otherwise, however, this Court has never found that it is a

defense to the assertion of infringement under the doctrine of equivalents that claim language was "deliberately" presented by the patentee to the patent office. Instead, the doctrine of equivalents is concerned with giving the patentee the full value of its invention, recognizing "language's inability to capture the essence of innovation." *Id.* at 734.

4. This Case is an Ideal Vehicle for Curtailing the Federal Circuit's Disregard of this Court's Doctrine of Equivalents Case Law

Several points should be made in response to GameTech's argument that this case is a "poor vehicle" for examining the doctrine of equivalents. Opp. 22-24. First, Planet Bingo does not seek a fundamental re-examination of the doctrine of equivalents. This Court has already provided that, most recently in *Festo* and *Warner-Jenkinson.* The purpose instead is to ensure that the Federal Circuit is following this Court's teachings regarding the doctrine of equivalents, and not applying "a test inconsistent with [this Court's] . . . patent law decisions." *Cf. KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1743, 167 L.Ed.2d 705 (2007).

Second, this case comes at the right time. The first vitiation decision was issued in 1997. *See Sage*, 126 F.3d 1420. Over the last decade, the doctrine has had ample opportunity to grow and develop, and has done so in ways that are inconsistent and confusing to the district courts. This case exposes the fault line running through the Federal Circuit's conflicting vitiation case law. *See, supra*, 3-4.

As evidenced in the Federal Circuit's opinion below and in the other 2007 vitiation decisions, the doctrine continues to find application and, indeed, is showing signs of dramatic expansion. Following *Planet Bingo v. GameTech*, not only the inclusion of specific claim language will be

considered a "deliberate and foreseeable claim drafting decision," justifying a finding of "vitiation." Now, even words in a court-supplied interpretation of a claim term will support invocation of the doctrine, a step that essentially removes all foreseeable bounds on its application.[4] The potential applicability of vitiation to all equivalence cases has led one commentator to argue that "[i]n the years to come, it may well be that this [vitiation] doctrine will have more impact than Festo on how and when the doctrine of equivalents may be applied in patent litigation." Calvin P. Griffith, *The Law, Technology & the Arts Symposium: The Past, Present and Future of the Federal Circuit*, 54 Case W. L. Rev. 851, 855 (2004). If unchecked by this Court, the vitiation doctrine will effectively "overrule" *Warner-Jenkinson*. *See, e.g.*, Pribish, *Freedman Seating Co.*, 43 San Diego L. Rev. at 396 ("The available [vitiation] theories are simply too broad, and without restraint could lead to the vitiation of the doctrine of equivalents itself.")

Another reason why this case is ideally suited for a consideration of the vitiation doctrine is that the disputed claim element – a "predetermined winning combination" – is, according to the Federal Circuit's own opinion, "certainly" present in the accused game. App. 9a. It is doubtful that this Court will again find such a clear admission that the vitiation doctrine has nothing to do with the "all elements" rule, despite the Federal Circuit's purported reliance on *Warner-Jenkinson*.[5]

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[4] GameTech tries to suggest that the word "before" is actually in the claims, arguing that the "pre" in "predetermined" "means 'before.'" Opp. 21. GameTech is again engaged in a re-writing of the opinions below, which did not base their holdings on a linguistic deconstruction of the term "predetermined." GameTech also did not advocate this below.

[5] There is no merit to GameTech's argument that there are "independent, alternative grounds for affirming the decision below." Opp. 22. Neither court below ever ruled on GameTech's other theories. See Opp. 6, n. 3;

5. Where the Facts are in Dispute, Resolution of the Doctrine of Equivalents is a Jury Issue

With respect to the second question presented by the petition, GameTech contends that Planet Bingo somehow waived its jury argument because it did not raise it until its Petition for Rehearing below. Opp. 24. The cases cited by GameTech do not stand for the proposition that an argument concededly raised below in a petition for rehearing is waived. In any event, the essence of Planet Bingo's arguments against the vitiation doctrine – as to which GameTech makes no waiver argument – is that "a finding of 'vitiation' is only appropriate '[w]here the evidence is such that no reasonable jury could determine two elements to be equivalent.'" Pet. 26 (quoting *Warner-Jenkinson*, 520 U.S. at 39 n. 8.) To the extent that GameTech is asserting that the precise phrasing of Planet Bingo's second question was different prior to the Petition for Rehearing stage below, that does not establish waiver. *See Nelson v. Adams USA, Inc.*, 529 U.S. 460, 469, 120 S.Ct. 1579, 1586 (2000).

It is not Planet Bingo's contention that "every case involving the doctrine of equivalents must go to a jury[,]" as GameTech asserts. Opp. 25.[6] However, before it may

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Opp. 22. Before this Court will consider alternative grounds to support a judgment, these must actually have supplied the basis for that decision. *See, e.g., Matsushita Elec. Indus. Co., Ltd. v. Epstein*, 516 U.S. 367, 379, 116 S.Ct. 873, 880 (1996). Also, having sought and obtained summary judgment, it is disingenuous for GameTech to now argue that the record below is somehow lacking in "any concrete detail." Opp. 23.

[6] Elsewhere, GameTech takes the opposite approach, and tries to find an admission that GameTech was entitled to summary judgment, based on Planet Bingo's effort to obtain summary judgment in its favor. Opp. 24. Clearly, a party can seek summary judgment based on an assertion that the evidence supporting *its* position is undisputed, while arguing that, at a minimum, it has at least succeeded in raising a disputed issue of fact

decide equivalence as a matter of law, the district judge must determine, based on a review of the "evidence," that "no reasonable jury could determine two elements to be equivalent." *Warner-Jenkinson, supra*. The jury may not be replaced by resort to a thesaurus. As GameTech's opposition makes clear, it believes that a "deliberate" inclusion of a claim element precludes an assertion of equivalence. The court below so held. If this is the law, the jury has in fact been ousted from the equivalence analysis.

CONCLUSION

For the foregoing reasons, and for the reasons stated in the petition for certiorari, the petition should be granted.

Respectfully submitted,

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precluding summary judgment in favor of its opponent. The district court's and Federal Circuit's clear statements regarding Rainbow Bingo's "predetermined winning combination" and "predetermined aspects," *supra*, reflect that Planet Bingo had a credible basis for such action.